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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/554,211	05/10/2000	COREY JAMES KENNEALLY	6934	6519

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EXAMINER

CARR, DEBORAH D

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 01/15/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/554,211	Applicant(s) Kenneally et al.
	Examiner Deborah D. Carr	Art Unit 1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 9 Oct 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 11-39 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 11-39 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|--|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 20) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9 October 2001 have been fully considered but they are not persuasive.

Inclusion of claims 1-10 on PTO-326 was a clerical error. Applicants should note that claims 11-39 were properly acted upon in the office action dated 5 July 2001.

Claim Rejections - 35 USC § 112

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 38-39

Applicants' argue that the open terminology of the word "comprising" in claim 37, includes additional components therefore suppling the support for the presence of the esterified polyol recited in dependent claims 38-39. Applicants' have defined or claimed the alkyl esters of claim 37 via "product-by-process" terminology and should be aware of the fact that this types of claims are examined based on the product and not the process step. As stated in the MPEP, chapter 2100, section 2113, "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself." The product as claim in step (d) is a highly pure fatty acid lower alkyl ester.

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The examples supplied does not show the presence of an esterified polyol. Applicants may have inadvertently claimed dependency of claim 38-39 on the wrong claim and they should depend from claim 35 which reads on an esterified polyol product.

Claims 11-39

All thought the claims are read in light of the specification, applicants are required to point out and distinctly claim the subject matte which is regarded as the invention. The second paragraph of 35 U.S.C. § 112 requires that the claims particularly point out the subject matter that applicant regards as the invention. A claim referring to the specification is improper except in rare instances. Ex parte Fressola, 27 U.S.P.Q.2d 1608 (U.S. Pat. & Trademark Bd. Pat. App. & Int 1993). The examiner stated in the rejection the various steps which were lacking the in claims, see page 4, lines 3-6, contrary to applicants' statements starting on page 2, last paragraph to page 3, 1st, 2nd and 3rd paragraphs. Applicants should again review MPEP 2172.01 in regard to the requirements for essential matter.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 11-13, 17-18, 20, 32 rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP'485.

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Applicants cite various case law including Ex parte Levy, to support their argument that the requirement of the examiner has to specifically list page and line where the anticipated material is located in the prior art reference. However, the MPEP which is my guideline for the examination of applications states the following:

37 CFR 1.104 Nature of Examination

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best reference at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicants, the particular part relied on must be designated as nearly a practicable, the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

One skilled in the art is presumed to be able to interpret a generic disclosure. See, Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 U.S.P.Q.2d 1843 (Fed. Cir. 1989); In re Susi, 440 F.2d 442, 445, 169 U.S.P.Q. 423, 425 (C.C.P.A. 1971); In re Corkill, 771 F.2d 1496, 226 U.S.P.Q. 1005 (Fed. Cir. 1985). The prior art reference consist of 5 pages and the examples and claims specifically indicate the process steps. It is unclear how one of ordinary skill in the art would have difficulty identifying the element which reads on the instant invention since the reference is not complexed or describes other inventions.

According to the specification, elevated temperatures for the water-washing step range from 20°C to 93°C and the pressure was “slightly raised, typically 1000 mm/Hg(5 psig). The examples are silent in regard to the elevated pressures that are required for the water-washing step. In fact, the water-washing step of the instant invention is conducted exactly as the water-washing step of EP'485.

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Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

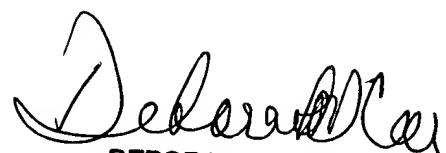
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Deborah D. Carr whose telephone number is (703) 308-4627. The examiner can normally be reached on Monday thru Friday from 8:30 a.m. to 5:00 p.m. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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DEBORAH D. CARR
PRIMARY EXAMINER

ddc

10 January 2002